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THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

This opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

*Ex parte* DANIEL J. McDONALD, JOHN A. WOLFE  
and HERBERT R. WOLF

Appeal No. 95-0604  
Application No. 07/858,248<sup>1</sup>

ON BRIEF

Before THOMAS, KRASS and JERRY SMITH, *Administrative Patent Judges*.

JERRY SMITH, *Administrative Patent Judge*.

#### DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-11, 16 and 17. Claims 12-15 have been indicated as containing allowable subject matter and form no part of this appeal.

<sup>1</sup> Application for patent filed March 26, 1992.



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Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

#### OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the collective evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-11, 16 and 17. Accordingly, we reverse.

Appellants have nominally indicated that the claims on appeal should stand or fall together in eight separate groups. The examiner, on the other hand, argues that the claims should all stand or fall together as a single group because appellants

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make the same arguments with respect to all the groups. The question of claim grouping should not be confused with disposition of the claims on the merits. In order to have the claims considered separately for patentability, appellants must only provide separate arguments for the claims. This decision to separately argue claims falls entirely within the discretion of the appellant and cannot be denied by the examiner. Although different claims may be argued separately by appellants, and will then be considered separately, the disposition of the claims may be decided on reasons previously discussed where the arguments for separate patentability are simply repetitive. Thus, we will consider the claims on appeal before us separately to the extent that appellants have provided separate arguments for patentability.

We consider first the rejection of claim 1. The examiner points out what he perceives to be taught by Takasugi on pages 3-4 of the answer. The examiner basically construes claim 1 to be broad enough that, in his opinion, the type of interruption recited in claim 1 would have been suggested by the Takasugi system. Appellants respond that Takasugi provides no teachings that would provide for interruption of a communication of one communication source by another communication source. Since

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interruption is neither taught nor suggested by Takasugi, as argued by appellants, they contend that claim 1 is not taught by the teachings of Takasugi [brief, pages 8-9].

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and compare Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 1535, 218 USPQ 871, 876 (Fed. Cir. 1983). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572,

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1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Claim 1 recites a method for selectively controlling the conditions under which a second member of a user group can interrupt the communication of a first member of the user group. The only interruptions described in Takasugi are the interruptions or requests that each station may make of the central control computer. It should be noted here that Takasugi does not describe any aspect of what happens in his system once a station has obtained access to the computer. In other words, once a station has received access to the computer in Takasugi, Takasugi describes nothing about how a different station can bump the first station off or interrupt the communication of the station which has been given access. Takasugi only describes how a specific one of a plurality of stations is selected when they are simultaneously requesting access to the computer.

Once a station is selected based on some scheme in Takasugi, there is no further disclosure as to what happens.

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The examiner appears to be reading teachings into Takasugi which simply are not there. The answer states that "[t]he [Takasugi] system operates such that a unit can transmit if it has the highest priority (thus establishing a route), during the next 'first slot' another unit with higher priority can 'interrupt' the previously connected unit and connect itself to the communication line thereby creating another route" [answer, page 4]. We have carefully reviewed Takasugi and cannot find support for this position of the examiner. Takasugi does not describe what the central computer will do if a second station attempts to access it while it is processing a previous access from another station. The examiner is simply speculating as to what might happen if such another request for access or "interruption" should occur. The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). No teachings regarding the manner in which one communication is interrupted by another come from Takasugi.

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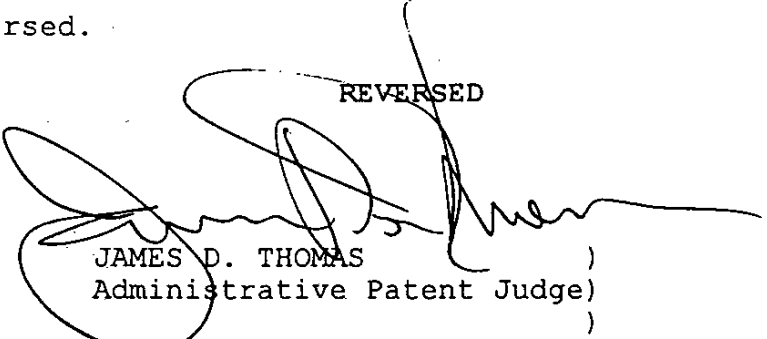
Although the examiner may have felt confident that interruptions of the claimed type must be suggested by Takasugi, we find the reference does not support the teachings attributed to it by the examiner. Since Takasugi discloses nothing regarding the manner in which interrupts of the type claimed would be handled, Takasugi fails to support the rejection offered by the examiner. Therefore, we do not sustain the rejection of claim 1.


Since all the remaining independent claims recite a method of controlling communication interrupts in a manner analogous to that of claim 1, we conclude that the teachings of Takasugi do not support a case of obviousness for any of the claims on appeal before us. Therefore, we do not sustain the rejection of any of the claims based upon the teachings of Takasugi.

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The decision of the examiner rejecting claims 1-11, 16 and  
17 is reversed.

REVERSED

  
JAMES D. THOMAS  
Administrative Patent Judge)

  
ERROL A. KRASS  
Administrative Patent Judge)

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